

**TRADE MARKS ACT 1994  
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF International Registration No 721360  
in the name of KLIKO Entsorgungssysteme GmbH & Co**

**AND IN THE MATTER OF Opposition by Environmental  
Campaigns under No 70304 to the protection of the  
International Trade Mark in the UK**

**BACKGROUND**

1. On 24 June 1999, KLIKO Entsorgungssysteme GmbH & Co designated the UK for the purposes of protecting its international registration No. 721360. The international trade mark (UK) is shown below.



2. Protection is sought in respect of:

**Class 06**

Container and tubes of metal.

**Class 09**

Magnetic identification cards; weighing, measuring and checking (supervision) apparatus and instruments.

**Class 19**

Tubes of synthetic material.

**Class 20**

Container of synthetic material.

3. The holder of the international registration claims a priority date of 6 February 1999 based upon an earlier filing of the same trade mark in Germany.
4. The designation was subsequently published in the Trade Mark Journal under article 10(1) of The Trade Marks (International Registration) Order 1996.
5. Within the period allowed under article 10(2) of the Order, opposition was filed by Environmental Campaigns of Wigan. The opponent is a registered charity limited by guarantee. The charity is the result of an association between the charities The Tidy Britain Group and Going for Green.
6. The grounds of opposition are, in summary, that:
  - the opponent, or one of the constituent charities, is the proprietor of eight earlier trade marks, including the mark shown below;



- this mark is registered in the UK under numbers 1445088/89/91 in respect of:
  - Bins, boxes, key fobs, key rings and badges; all included in Class 6.
  - Bins, containers, boxes, all made of wood and/or plastic; key fobs and key rings; all included in Class 20.
  - Advisory and consultancy services relating to the environment, ecology, litter abatement, litter control and waste disposal; all included in Class 42.;
- the international trade (UK) is to be protected for containers of metal and of synthetic material, which are identical goods to 'bins' in respect of which the earlier trade mark is registered in class 6 under No 1445088 and 'bins and containers' for which the earlier trade mark is registered under No 1445089 in Class 20;

- if the international mark is used in respect of these goods, there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark with the result that protection of the international trade mark would be contrary to Section 5(2)(b) of the Trade Marks Act 1994;
- the remaining goods covered by the international registration are dissimilar to the goods and services for which the earlier trade mark is protected;
- the opponent's earlier trade marks have been used extensively in relation to national environmental campaigns and on T-shirts, bins, printed matter, educational services and related merchandise;
- the opponent enjoys a reputation in its earlier trade marks and use of the international mark on dissimilar goods would, without due cause, take unfair advantage of, and would be detrimental to, the distinctive character and repute of the earlier marks;
- registration would therefore be contrary to Section 5(3) of the Act;
- use of the international mark in the UK would be liable to be prevented by the law of passing off, and granting protection to it would therefore be contrary to Section 5(4)(a) of the Act;

7. There was originally a further ground of opposition under Section 5(4)(b) of the Act but this is no longer pursued and I need not, therefore, say any more about it.

8. The holder of the international registration filed a counterstatement denying the grounds of opposition. I note the following points:

- it is accepted that 'bins' in Class 6 are similar to the 'containers of metal' in Class 6 and that 'containers of plastic' in Class 20 may be similar to 'containers of synthetic material';
- the holder's mark is not similar to any of the opponent's earlier trade marks, and there is no likelihood of confusion;
- the holder of the IR claims to be the proprietor of UK registrations 1537248 and 1556806, which consist of the device the subject of the IR and the word KLIKO, and are registered in Classes 6 and 20 for, inter alia, containers of metal and plastic, respectively;
- the registered mark has been used in the UK since at least as early as 1991 without any confusion or association with the opponent's marks;

- whilst it is accepted that there has been some use in the UK of the earlier trade marks relied upon by the opponent, the opponent is put to proof that this use has trade mark use, or in the course of trade, or that the earlier trade marks have acquired a relevant reputation as a result;
- it is not clear which of the earlier trade marks the opponent relies upon to support its Section 5(3) ground of opposition.

9. Both sides seek an award of costs.

10. The matter came to be heard on 1 October 2002 when the holder of the international registration was represented by Ms Arenal of Mewburn Ellis, Trade Mark Attorneys, and the opponent was represented by Mr Wallace of Boulton, Wade and Tennant, also Trade Mark Attorneys.

## **THE EVIDENCE**

11. The opponent's evidence is contained in a statutory declaration and a later witness statement by Anthony Gordon Palmer, who is the Services Manager of Environmental Campaigns.

12. Exhibits AG4-AG9 to Mr Palmer's declaration demonstrate how the opponent's mark has been used in the UK. Exhibit AG4 consists of pages from the Tidy Britain Group's website. These pages were downloaded in April 2000. They show use of a sign similar to (but not identical with) the device mark upon which the opponent relies. The device appears as part of a composite sign which includes the prominent words 'Tidy Britain Group'. One of the web pages is a 'history page'. This indicates that the 'international tidy man logo' appeared for the first time in the UK in 1969 on bins and packaging. There is also a 'sponsors page' which lists well known corporations which have supported various projects run by the Tidy Britain Group.

13. Mr Palmer says that his company's trade marks have been used on a range of goods, including bookmarks, t-shirts, key fobs, badges, fridge magnets, baseball hats, toys, games, mugs, ties, tie-pins, polo shirts and bags. Exhibit AGP5 is said to show this use. The exhibit contains copies of material showing use of a sign similar to the earlier trade mark of the opponent on a bookmark, a t-shirt, a key fob, and a game. None of these exhibits are dated.

14. Exhibit AGP10 to Mr Palmer's declaration consists of photographs and slides showing a sign similar to the opponent's earlier trade mark appearing on various litter bins. Again this material is not dated.

15. Mr Palmer provides figures representing the turnover in the UK of goods sold by his company or under licence bearing what he calls "the MAN device" since 1994. These show a turnover of just over £2M in 1994 rising to £4.2M in 1998. It is not entirely clear which goods this claim relates to.

16. Mr Palmer continues that the majority of his company's goods are distributed free to schools, local authorities, corporate organisations, individuals, voluntary organisations and

media organisations in order to promote awareness of the ways in which the environment is at risk.

17. Mr Palmer also provides figures for 1994-2000 for the sums expended “promoting the goods in connection with my company’s registrations”. The figures provided show that the opponent usually spends in excess of £100K per annum on such promotion.

18. Exhibit AGP7 is said to consist of “*examples of the use made of My (Mr Palmer’s) Company’s Registrations since 1971, to include advertising and promotional material*”. The exhibit consists of a whole mass of printed material, garments, a flag, posters, a mug, ties, a learning kit for children, tie-pins and a bag. I have been through all this material. It is consistent with the Tidy Britain Group being an organisation that has run environmental campaigns for many years. Much of the material carries a sign similar to the opponent’s earlier trade mark, often in combination with the words ‘Keep Britain Tidy’ or ‘Tidy Britain Group’. A few of the items, such as the bag, self-evidently post date the international registration. Apart from this item, the printed material and the posters, none of the other exhibits carry a date. One of the five t-shirts in evidence (which is said to date from the “*early 1990s*”) features the ‘tidy man device’ in a position on the breast consistent with its function as a trade mark. It has no other trade mark. The other four (three of which are claimed to date from the same period) all carry other marks in the neck tag. The use of the tidy man device on the front of the other four t-shirts appears more consistent with it being used purely to promote an environmental campaign, or is at least ambiguous in nature. The use shown on the other goods is similar.

19. There is, therefore, little in this exhibit which supports the opponent’s contention that its contents shows use of the earlier trade mark (or one of the numerous small variations thereof used over the years) as a trade mark for goods.

20. However, there is some evidence in exhibit AGP7 which supports the opponent’s claim that the Tidy Britain Group sells goods bearing the ‘tidy man device’ as a trade mark. It includes a copy of a price list for “*the country’s first Tidy Shop in Wigan*”. It is undated, but shows that the Tidy Britain Group has offered goods for sale carrying the ‘Tidy Britain Group trade mark’. It is not entirely clear what this means, but I note that the list also states that “*all goods bearing the Group Tidy man logo are of a high standard and made in Britain*”. It therefore seems likely that the goods carried a version of the tidy man device similar to the earlier trade mark, possibly with the ‘Tidy Britain Group’ name. The goods listed are all traditional merchandising items, such as bags, stickers, T-shirts, sweatshirts, bookmarks, key rings and badges. There is nothing in the list in the nature of a bin.

21. I note that the exhibit also includes a leaflet entitled “*Why your help is so important to Keep Britain Tidy*”. It is aimed at traders who use packaging material and carries an offer of assistance in applying the ‘Tidy man symbol’ to packaging. The symbol, which is one of the greater variations on the earlier trade mark, is described as “*being heavily promoted as the anti-litter symbol*”. The purpose in applying it to packaging is said to be to encourage the public to dispose of their litter responsibly.

22. Exhibit AGP8 consists of a list of well known companies who are authorised to apply the opponent's 'logo' (which I assume to mean the 'tidy man logo') to the packaging or containers for their products. Some of these organisations appear to have provided the Tidy Britain Group with financial support.

23. Exhibit AGP9 to Mr Palmer's declaration consists of a copy of a report written by MORI following a survey of 1759 adults at various locations throughout the UK in July 1999. Respondents were shown a composite sign consisting of a device similar to the opponent's earlier trade mark and the words TIDY BRITAIN GROUP. The report records that when asked whether they had seen this sign before, 79% of respondents indicated that they had. Not surprisingly (given that TIDY BRITAIN GROUP was part of the sign that was shown to respondents) 26% of respondents answered 'Tidy Britain Group' when asked which organisation uses the sign. A further 17% answered 'Government' or 'Council'. A further 7% said an environmental group. 4% said 'Keep Britain Tidy'.

24. Mr Palmer concludes his statutory declaration as follows:

*"... I know of no other person, firm or corporation who uses the MAN Device in relation to goods and services covered by My Company's Registrations other than My Company, all corporate members of Tidy Britain Group, local authorities who have contracted with Tidy Britain Group in the People & Places Programme and all corporate partners from time to time who are authorised to use the MAN device during the period of "partnership", for example Coca Cola, the Wrigley Company, Barclays Bank etc. Indeed, I believe that if The Applicant's trade mark for MAN & BROOM Device were allowed to proceed to registration in the UK such registration and subsequent use of the mark would be confusing with My Company's use and take unfair advantage of My Company's reputation in the MAN device."*

25. The applicant's evidence includes a witness statement by Hans Jorg Schreiber who has been an officer of the holder of the IR since 1995, and has full access to company records.

26. Mr Schreiber states that his company operates in the UK through a subsidiary company called Kliko Environmental Systems Limited. He says that the mark applied for (which he describes as the 'Man with Broom device') has been used in the UK since at least as early as 1991 in relation to waste containers and related services. He claims that the mark is sometimes used together with the word mark KLIKO (as per existing UK registrations 1537248 and 1556806) and sometimes alone.

27. Mr Schreiber provides turnover figures for the UK in respect of his company's products under trade marks "*consisting of or prominently incorporating the Man and Broom Device*". These show a turnover of around £1M in 1991 rising to almost £3M in 1993. Turnover dropped thereafter to a low of £760K in 1995 before rising again to almost £3M in 1998, the last full year preceding the date of the IR with its priority claim.

28. Exhibit HS2 to Mr Schreiber's statement includes examples of use of the mark on various waste bins and containers. Some of the products shown do not show use of the mark at all. Where the Man and Broom device does appear it is always in conjunction with the word KLIKO.

29. Mr Schreiber further indicates that:

- his company's products under the mark are generally for commercial or industrial use;
- his company's products have been regularly promoted at various trade shows and in specialist publications, such as Recycling Weekly, Government Business and Horse and Hound, and through direct mail shots to potential customers;
- around £20K per year is spent promoting products under the mark in the UK.

30. A list of the holder's larger clients in the UK is provided. This includes seven councils, two medical organisations, a pharmaceutical company and a waste management organisation.

31. The holder of the IR also submitted a witness statement by Sofia Arenal, the holder's UK Trade Mark Attorney, which sets out how she conducted a mini survey of eleven people at different businesses and organisations throughout the UK. No explanation is provided as to how these eleven people were selected but it appears probably that they work for organisations that have done business with the holder of the IR's UK subsidiary or, in one case, is a competitor thereof. A sample of the letter sent to these people is included as exhibit SA1 to Ms Arenal's statement. A copy of the mark applied for was attached to the letter. The letter asks the recipient whether he or she had seen this logo before and, if so, in what context.

32. Ms Arenal explains that she received four written or telephone responses from persons who recognised the logo and knew it was used by a company called Kliko. Two negative responses were received. The rest did not reply.

33. Three of the four persons who responded positively to the letter went on to make witness statements. Mr Mark Whiteman and Mr Michael Wood work for companies selling advertising and promotional gifts. It transpires that both their companies have in the past supplied, or at least bid to supply, the holder's UK subsidiary with promotional material bearing the Man and Broom device. It is hardly surprising, therefore, that they recognised the holder's mark.

34. The third witness statement comes from a Stephen Geoffrey Smith, who is the Purchasing Director of Greenham Trading Limited. The company provides industrial supplies from branches throughout the UK. Mr Smith identifies Kliko Environmental Systems Ltd as one of its main suppliers of environmental control products. Not surprisingly, he also recognised the Man and Broom logo.

35. The fourth positive respondent, from Andrew Corless, Joint Managing Director of Otto (UK) Ltd, a competitor of the above named company, responded with a two line letter simply stating that he recognised the logo sent to him as being "*the Kliko man logo*".

36. Mr Palmer's second witness statement on behalf of the opponent was filed in reply to the holder's evidence. It consists mainly of argument rather than factual evidence. However, I note that:

- Mr Palmer draws attention to the fact that, despite a claim to the contrary, the holder's evidence includes no examples of the Man and Broom device being used without the word KLIKO;
- he accepts that there has been no confusion to date as a result of the use of the Man and Broom device, but attributes this to the use of the device with the word KLIKO.

### **FINDINGS OF FACT ON THE EVIDENCE**

37. The opponent's evidence establishes that, at the date the UK was designated for protection and at the earlier priority date, the Tidy Britain Group was an established charity which had conducted environmental campaigns to educate the public in the UK about the dangers of litter and the importance of disposing of it responsibly.

38. A mark similar to the opponent's earlier trade mark registered under numbers 1445088/89/91, which the opponent describes as 'the tidy man logo', had been used by the Tidy Britain Group, and by others with its consent, as part of these campaigns. I am satisfied that a significant proportion of the public would have associated the mark in question with these campaigning activities. The registered mark shares the same distinctive character as the tidy man logo and this mark would therefore also have been associated with these campaigning activities.

39. The use of the tidy man logo on litter bins shown in exhibit AGP10 to Mr Palmer's declaration has not been established prior to the priority date claimed for the IR or prior to the date of designation of the UK. Equally fundamentally, the use has not been shown to be as a trade mark for these goods. Rather it appears to have been used as an anti-litter symbol in connection with the aforesaid campaigning activities. The use of the mark on packaging materials falls into the same category.

40. There is evidence of use of the mark in relation to various merchandise such as T-shirts key fobs and stickers. Although this use also appears to have been intended to promote the environmental campaigns of the Tidy Britain Group, some of it also seems to have served to have identified the trade source of the goods and is therefore trade mark use. The opponent has not provided specific information about the extent of such use of the mark in relation to individual products. Further, the turnover figures provided by the opponent include (unnamed) goods sold under licence. The nature of these licences has not been satisfactorily explained, which is particularly significant in this case because, as the opponent points out, the majority of goods bearing the mark are given away without charge as promotional items. The evidence fails to distinguish adequately between goods bearing the tidy man logo that were given away as



promotional items either by the Tidy Britain Group or with its consent, and those goods which carried the tidy man logo as a trade mark for the product on which it appeared. I am left with the impression that the use of the tidy man logo has been predominantly as a symbol of the opponent's environmental campaigns and its use as a trade mark for a range of merchandise has been largely ancillary to such use. This would explain why local authorities were the second most popular group associated with the tidy man logo and the words TIDY BRITAIN GROUP in the survey conducted on behalf of the opponent.

41. As far as the IR holder's evidence is concerned, it establishes that the mark which is the subject of the IR has been used in the UK since 1991 as part of a trade mark for waste containers and related services. The evidence indicates that the device has always been used in conjunction with the word mark KLIKO. It is therefore of limited probative value when it comes to assessing the likelihood of confusion between the holder's man and broom logo solus, and the marks relied upon by the opponent. The absence of any established trade mark use of the opponent's mark for waste containers is also relevant when it comes to assessing the significance of the accepted absence of confusion between the respective trade marks to date.

42. The mini survey conducted on behalf of the holder by its UK Trade Mark Attorneys establishes that some of the organisations that have done business with the holder's UK subsidiary associate the man and broom device with it rather than the opponent or the Tidy Britain Group. I find this unsurprising given their trading relationship to the holder's subsidiary. The survey is, in any event, too small and selective to produce meaningful results.

43. At the hearing, Ms Arenal attached particular importance to the letter from Otto (UK) Limited described at paragraph 35 above. She pointed out that this letter came from a competitor of the holder's subsidiary rather than a party with a trading relationship with it. However, the weight that can be attached to this letter must reflect the fact that Mr Corless' response was very brief and lacked any explanation for his company's familiarity with the holder's mark, and was not submitted as formal evidence in the form of a witness statement. Consequently, the opponent was denied the opportunity of testing his evidence because formally Mr Corless is not a witness at all. Considered merely as a one sentence answer from one respondent in a survey his reply can carry little weight.

44. I do not therefore consider that the holder's evidence of use of its man and broom device as part of a composite trade mark for waste containers does much to rebut the opponent's contention of a likelihood of confusion between the man and broom device solus and the opponent's registered marks if they were used normally and fairly as trade marks in relation to bins and waste containers.

#### **DECISION - Section 5(2)(b)**

45. Section 5(2) is as follows:

*"5.-(2) A trade mark shall not be registered if because -*

- (a) *it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or*
- (b) *it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,*

*there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”*

46. The opponent relies upon its registrations in classes 6 and 20 to support the section 5(2)(b) ground of opposition. The trade mark that is closest to international trade mark is registered in these classes. In practice, it is therefore only necessary to consider the opposition based upon UK registrations 1445088 and 1445089. It is common ground that these registrations are “earlier trade marks” within the meaning of that term in section 6 of the Act.

47. I remind myself of the guidance provided by the European Court of Justice (ECJ) in **Sabel BV v Puma AG** [1998] E.T.M.R. 1, **Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc** [1999] E.T.M.R. 1, **Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.** [2000] F.S.R. 77 and **Marca Mode CV v Adidas AG** [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, paragraph 29.

### **The Degree of Similarity between the Respective Goods**

48. The applicant accepts that the ‘bins’ covered by earlier trade mark 1445088 in Class 6 are similar to ‘containers of metal’ in Class 6 of the IR. The applicant also accepts that ‘bins, containers, all made of wood and/or plastic’ covered by earlier trade mark 1445089 in Class 20 may be similar to ‘containers of synthetic material’ in Class 20 of the IR.

49. The opponent argues that the respective goods described above should be considered to be identical. In this connection the opponent points out that waste bins and waste containers in Class 6 are alternative descriptions of the same product.

50. In my judgement the opponent’s submission is correct. Strictly, there may be some technical distinction between containers of plastic and containers of synthetic material in Class 20, but this would have no bearing on the likelihood of confusion and so these goods must also be considered to be identical or so nearly identical as to make no difference.

### **The Distinctive Character of the Earlier Trade Mark**

51. The opponent has not shown any trade mark use of its earlier trade mark in respect of waste bins or containers. The distinctive character of the earlier mark must therefore be assessed purely on the basis of its inherent characteristics.

52. The holder of the IR points out that the opponent neither claims, nor has, a monopoly in stylised representations of people as trade marks. It is implicit from this submission that stylised representations of people, particularly when the stylised person is depicted performing an activity depicting the goods in use (in this case litter being dropped into a waste bin) are not highly distinctive *per se*.

53. However, the stylisation of the person in the earlier trade mark does contain a certain distinctiveness because it is an extremely minimalist silhouette. The pointed ends of the limbs are particularly noticeable. The incomplete circular border adds a little more to the distinctive character of the mark. In my judgement, the very slightly stylised representation of a bin and piece of waste paper contribute relatively little to the distinctive character of the earlier mark (for bins/waste containers).

### **Similarity of the Respective Trade Marks**

54. The holder of the IR argues that there are strong visual differences between the international trade mark and the earlier trade mark of the opponent. It points out that:

- the earlier mark has an unusual border which is not present in the later mark;
- the stylised person depicted in the earlier mark has a torso that is completely separate from the legs whereas in the later mark the torso is only partly separated from the legs;
- there is some shading in the earlier mark which is absent from the later mark;
- the stylised person is bending slightly to the right in the later mark whereas in the earlier mark the person is bending to the left;
- the later mark shows a person grasping an old fashioned looking broom with two hands whereas the earlier mark contains instead two different but unidentifiable objects.

55. The opponent argues that the marks are similar because:

- the lower half of the human figure present in both the marks is made up of a rectangle with a triangle missing;
- the effect of this is to create two pointed legs with no feet;
- in both marks there is a degree of separation between the upper and lower half of the body, and in both marks the circular head is shown detached from the body;
- both figures have an arm or arms tapering to a point with no hands;
- both figures are engaged in tidying/cleaning activities.

56. It is important to bear in mind that the average consumer remembers trade marks by reference to the overall impression that they create rather than by way of a forensic analysis of their various features. I do not therefore believe that minor differences between the respective human figures in the marks, such as whether the upper and lower part of the body is fully or only partly separated, the presence or absence of shading, and whether the person is shown leaning to the left or right are likely to constitute material differences. My first impression was that the respective human figures in the marks are very similar. On closer analysis I can see the various differences (including the fact that the figure in the later mark has two arms against the single arm of the figure in the earlier mark) but these differences do not alter my initial reaction, which is that the respective human figures create a very similar impression.

57. The main differences between the marks is the absence from the later mark of the incomplete oval border in the earlier mark and the substitution of a broom for a waste bin and paper. I do

not find the absence of the border to be a strong distinguishing feature. The border in the earlier mark may have a certain individuality but in the end it is still just a border. The substitution of a device of a broom for the bin and paper in the earlier mark is more noticeable.

58. I do not believe that the substitution of the broom for the bin and paper significantly changes the conceptual identity of the respective marks, which as the opponent submits, remains one of cleaning/tidying activities. However, bearing in mind the nature of the goods in question the concept is not distinctive and the conceptual similarity between the marks should not therefore be given more weight than it deserves. The most that can be said from the opponent's perspective is that there is no significant conceptual dissimilarity which will help to offset the visual similarity between the marks.

59. These are visual marks and there is therefore little point in considering the extent of any aural similarity.

### **Likelihood of Confusion**

60. I have already noted that there is no evidence that the earlier mark has been used as a trade mark in respect of the goods I have found to be identical to containers in classes 6 and 20 in respect of which the holder of the IR seeks protection for its mark. Nevertheless, in the absence of an application to revoke the earlier trade marks, section 72 of the Act requires me to consider the earlier mark to have validly registered at all times. This is consistent with the view expressed in Kerly's Law of Trade Marks and Trade Names (13<sup>th</sup> Edition), paragraph 8-25 of which is as follows:

*It is suggested that the correct approach is to consider a normal and fair use of the mark the subject of the application and, where the earlier mark is a registered mark which has not been used, a normal and fair use of it and, in the absence of argument or evidence to the contrary, the way in which the proprietor has used it can be said, at the very least prima facie, to be the paradigm case of its use in a normal and fair manner.@*

61. It is common ground that the average consumer for bins and containers would include both industrial customers and ordinary members of the public. Such consumers would pay a reasonable amount of attention to their purchase but, particularly in the case of ordinary members of the public, not the very highest degree of attention.

62. Taking all the points set out above into account I have reached the conclusion that the stylised human figures within the respective marks create very similar overall impressions and the absence of the border from the later mark and the substitution of a broom for a bin and paper are insufficient differences to avoid a likelihood of confusion if these marks were used concurrently as trade marks in relation to identical goods being bins and containers.

63. In my judgement the differences between the marks are likely to be lost through defective recollection of the earlier trade mark. Further, because the human figure in the later trade mark captures the distinctive character of the figure in the earlier trade mark, those consumers who are aware of the main difference between the respective marks – the substitution of a broom for a bin

and paper – are likely to mistakenly believe that the respective marks are variant trade marks used by the same undertaking or by undertakings with an economic connection.

64. I conclude that the section 5(2)(b) ground therefore succeeds to the extent pleaded by the opponent, that is with regard to ‘containers of metal’ in Class 6 and ‘containers of synthetic material’ in Class 20.

### **DECISION – Section 5(3)**

65. Section 5(3) of the Act is as follows:

*“5.-(3) A trade mark which -*

- (a) is identical with or similar to an earlier trade mark, and*
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

*shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”*

66. The purpose and scope of Section 5(3) of the Act has been considered in a number of cases including **General Motors Corp. v Yplon SA** (Chevy) 1999 ETMR 122 and 2000 RPC 572, **Premier Brands UK Limited v Typhoon Europe Limited** (Typhoon) 2000 FSR 767 and the **Daimler Chrysler v Alavi** (Merc) 2001 RPC 813, and **C.A. Sheimer (M) Sdn Bhd's TM Application** (Visa) 2000 RPC 484.

67. The points that come out of these cases are as follows:

- a) 'Reputation' for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (paragraph 26 of the ECJ's judgement in Chevy);
- b) Protection is only available where the respective goods or services are not similar (paragraph 29 of the Advocate General's opinion in Chevy);
- c) The provision is not intended to give marks "an unduly extensive protection" - there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General's Opinion in Chevy and paragraph 88 of Pumfrey J.'s judgement in the Merc case);

d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J. in the Typhoon case);

e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ's judgement in the Chevy case);

f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment, but is one form of detriment (paragraph 88 of Pumfrey J.'s judgement in the Merc case);

g) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive - blurring (paragraph 88 of Pumfrey J.'s judgement in the Merc case);

h) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in Visa at page 505, lines 10-17).

68. The opponent's Statement of Grounds of Opposition is ambiguous with regard to the earlier trade mark or marks that the opponent relies upon to support its objection under section 5(3). This was pointed out by the holder of the IR in its Counterstatement. Despite this the opponent did not make its position clear until the hearing of the opposition when Mr Wallace was content to rely upon earlier trade mark No 1445091, which is the same mark considered under section 5(2) but which is registered in Class 42 for 'Advisory and consultancy services relating to the environment, ecology, litter abatement, litter control and waste disposal'.

69. Mr Wallace argued that the opponent's reputation under its registered mark fell within this description of services. I disagree. It is important to recognise that in order to qualify for protection under section 5(3) the earlier mark must have a reputation as a trade mark for the goods/services in respect of which it is registered. I found earlier that the earlier trade mark is a sign which is widely associated with the opponent's environmental campaigns. Section 103(1) of the Act defines "trade" as including any business or profession. The definition of trade is deliberately wide. It appears wide enough to cover campaigning services provided by a charity. Arguably, the mark has therefore been used as a trade mark for the opponent's environmental campaigns. However, even if this is so, the environmental campaigns associated with the mark would not, in my view, naturally fall within the description of 'advisory and consultancy services'. If that is right the section 5(3) ground falls at the first hurdle.

70. The opponent grounds of opposition include a number of other marks which are registered for 'education and training services relating to litter and the environment'. An example of such a mark is shown below.



71. It appears to me that there may be a stronger argument for saying that the opponent's campaigning activities fall more naturally within the description of educational services. The difficulty the opponent faces is that:

- the opponent's evidence has not been directed at establishing that this mark, or any of the other marks in Class 41 listed in the pleadings, was known to a significant proportion of the relevant public at the relevant date in February 1999;
- this mark, and the others in Class 41, are less similar to the international trade mark than the mark registered under No 1445091 because they include further distinguishing words.

72. Consequently, even if I were to consider the opponent's case based upon one of its cited Class 41 registrations, the result would be the same.

73. In any event, the opponent has failed to properly explain how or why use of the holder's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of any of its earlier trade marks. At the hearing, Mr Wallace explained that the opponent's concern was that use of the later mark would dilute the distinctive character of the earlier trade marks "*and potentially also make it less attractive to third parties to use in conjunction with the opponent's activities*".

74. It is apparent from the case law summarised above that dilution *per se* will rarely be sufficient of itself to support a section 5(3) objection, particularly where the earlier mark has relatively little inherent distinctive character. The closest Mr Wallace came to explaining the more specific argument (in italics in paragraph 73 above) was that the dissimilar goods for which the holder seeks protection may have some tenuous connection with litter. In this regard he argued that a 'tube of metal' with a lid becomes a bin and that 'weighing and measuring apparatus' in Class 9 of the IR could have something to do with litter.

75. The first point sits ill with the opponent's contention that 'tubes of metal' are dissimilar goods to metal bins. The alleged dissimilarity between the respective goods, which I accept, illustrates the manifest weakness of the point. This point, and the other point about a possible



connection between litter and weighing and measuring apparatus, was raised by the opponent for the first time at the hearing. The points are not specifically addressed in the opponent's evidence, and because they had not been previously particularised, the holder of the IR did not have the opportunity to rebut these arguments with evidence of its own. In these circumstances it seems to me that I should be slow to attach much weight to the theoretical risks identified by Mr Wallace at the hearing. Consequently, even if the opponent had satisfied the essential conditions for invoking the exceptional protection afforded by section 5(3) of the Act, it has not satisfied me that use of the international mark would result in actual detriment to any of its earlier trade marks or any reputation they may in fact have.

76. The section 5(3) ground of opposition therefore fails.

#### **DECISION – Section 5(4)**

77. Section 5(4)(a) of the Act is as follows:

*“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -*

*by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.”*

78. The essential elements in the tort of passing off are well established and summarised in **WILD CHILD** 1998 RPC 455. The requirements are that:

- (a) The claimant possesses a goodwill in a business identified by some distinctive indicia;
- (b) There has been or is in prospect, a misrepresentation by the defendant (whether intentional or not) likely to engender a false belief that there exists a relevant trade connection between the goods of the defendant and the claimant;
- (c) With the result that there is damage to the goodwill of the claimant.

79. The courts have in the past been prepared to protect the goodwill of a charity: see **British Legion v British Legion Club (Street) Limited** (1931) 48 RPC 555 at 562. However, even if the opponent has an actionable goodwill under the tidy man logo it cannot in my judgement succeed to any greater extent than it has already done under section 5(2)(b). Although it is not a legal requirement that the parties must be in the same field of activity it is nevertheless significant that they are not. In these circumstances the burden on the opponent to demonstrate misrepresentation and damage becomes more difficult to discharge.

80. I am not persuaded that the use of the international mark on the goods that I have found to be free from objection under section 5(2)(b), which have no obvious connection with environmental campaigns, would amount to a misrepresentation or cause damage to the opponent's goodwill as a charity.

81. The section 5(4)(a) ground fails accordingly.

### **OUTCOME**

82. The opposition has succeeded in respect of containers in classes 6 and 20 but failed in respect of the balance of the goods covered by the IR. Subject to any appeal, protection will be refused in respect of containers but granted in respect of the remaining goods in the IR.

### **COSTS**

83. The opposition under section 5(2)(b) has wholly succeeded but the grounds under section 5(3) and 5(4) have failed. The opponent sought the complete rejection of the designation and measured in terms of goods allowed/disallowed the opposition has partly succeeded and partly failed.

84. In these circumstances I have determined that the parties should bear their own costs.

**Dated this 09 Day of January 2003**

**Allan James  
For the Registrar**